

REMARKS

In the Office Action, the Examiner objected to the specification; rejected claims 16-17 and 39-40 under 35 U.S.C. § 112, second paragraph; rejected claims 1 20, 21, 23, 33, 41, and 49 under 35 U.S.C. § 103(a) as unpatentable over WO 02/34003 A1 to Gemmer in view of U.S. Patent Publication Application No. 2002/0191597 to Lundstrom and U.S. Patent Publication Application No. 2002/0102970 to Moon; and rejected claims 2, 4-6, 8-19, 34-40, and 42-48 under 35 U.S.C. § 103(a) as unpatentable over Gemmer, Lundstrom, Moon, and paragraphs 0002-0015 of the Background of the instant application (hereinafter APA).

By this amendment, Applicants have amended claims 1, 21, 23, 33, 41, and 49 to more clearly define the features of those claims. Applicants submit that the claim amendments are supported by the specification (see, e.g., paragraphs 0027, 0051-0056, 0060, and FIGS. 2-3).

Claims 1, 2, 4-6, 8-21, 23, and 33-49 are currently pending.

Regarding the objection to the specification, Applicants submit that they are not required to define the phrase a "computer readable medium," as one of ordinary skill in the art would understand the meaning of that phrase.

Regarding the rejection of claims 16, 17, 39, and 40 under 35 U.S.C. § 112 for indefiniteness, Applicants submit that "the charging identifier" recited in those claims has antecedent basis in corresponding independent claims 1 and 33, both of which recite "a charging identifier." Therefore, the rejection of claims 16, 17, 39, and 40 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

The Examiner rejected claims 1, 20, 21, 23, 33, 41, and 49 under 35 U.S.C. § 103(a) as unpatentable over Gemmer, Lundstrom, and Moon. Applicants respectfully traverse this rejection.

Claim 1 recites a combination of features including, for example, “putting, in response to an invitation message, on hold a communication session between a user equipment associated with a first access network and a node of a communication system via a second network and at least one entity of said communication system between said user equipment and said node, the communication session established without preconditions to reserve resources for the communication session when the preconditions are not supported on the communication session between the user equipment and the node, the communication session established based on a session initiation protocol (SIP) and session data protocol (SDP).”

The Examiner alleges that Gemmer discloses the above noted feature of claim 1. However, Gemmer merely discloses placing a call on hold to allow a user to switch between two calls. As such, Gemmer's “hold” is initiated in response to a user wishing to speak to another caller rather than in response to an invitation message. Moreover, Gemmer merely discloses a call rather than a communication session based on SIP and SDP. To illustrate, Gemmer states:

[0022] If it turns out during the course of the call to the subscriber of the connection C that this subscriber wishes to speak to a subscriber other than the subscriber of the connection A, then the subscriber of the connection A can transmit a command to hold and forward to the switching center VER the connection to the connection C. Thus, at this time, the switching center holds two connections for the connection A, namely the original connection for the connection B and the call which was picked up later to the connection C.

Gemmer, para. 0022. Therefore, Gemmer fails to disclose or suggest at least the “putting” feature recited above with respect to claim 1. Moreover, although Moon discloses Internet access control and Lundstrom discloses charging, neither Moon nor Lundstrom discloses the above noted feature of claim 1.

On page 5 of the Office Action, the Examiner acknowledges that Gemmer and Lundstrom fail to disclose the following feature of amended claim 1: “resuming, in response to sending another invitation message and when the resources have been reserved, said communication session with the another message indicating an active session from said user equipment by which said charging identifier for the first access network is forwarded from said first node of the second network to a second node of the second network, wherein the first access network is different from the second network.” To cure that deficiency, the Examiner uses Moon at paragraphs 21, 22, 27, 29, and 30 to fill the gaps missing in Gemmer and Lundstrom.

In contrast to claim 1, Moon teaches away from resuming a session on hold by instead teaching a disconnection and then a reconnection after a user input command is received, obviating the need to place a session on hold and then resuming that session. Specifically, Moon states:

[0029] If the web command input wait time has not elapsed, the controller 10 returns to step 408 and continues to await the user input data while maintaining the Internet access. Otherwise, if the web command input wait time has elapsed in step 416, the controller 10 proceeds to step 418 and temporarily releases the Internet access after displaying the web document, until the user inputs another URL, clicks a hyperlink on the displayed web document or refreshes the web document. In this state, the mobile subscriber can receive an incoming call even while reading the web document. **The controller 10 displays the web document on the**

display 80 continuously though the Internet access is released in step 418 and awaits user input data in step 420 . The user can search the web document displayed on the display 80 using a function such as a scroll function.

[0030] Upon receipt of a web command from the user in step 422 , the controller 10 returns to step 402 and then resumes an access to the Internet 208 . To sum up, when there is no input from the user for a predetermined time after the Internet access has been established, the controller 10 temporarily releases the Internet access and thereafter, resumes the Internet access upon receipt of a web command from the user. In addition, if the user inputs an Internet access end request in step 420 , the controller 10 detects the Internet access end request in step 424 and then proceeds to step 414 to release the Internet access.

Moon, paragraphs 0029 and 0030. Emphasis added. FIG. 4 of Moon is reproduced below:

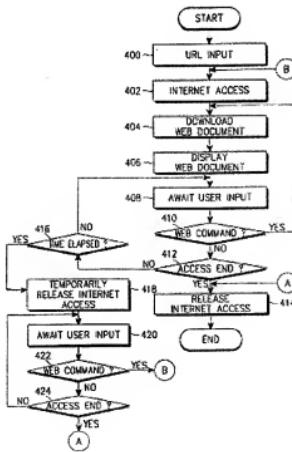


FIG. 4

In view of the foregoing, Moon fails to disclose or suggest at least the "resuming" feature noted above with respect to claim 1. Moreover, neither Gemmer nor Lundstrom

cures this noted deficiency as recognized by the Examiner at page 5, second paragraph, of the Office Action. Therefore, claim 1 is allowable over Gemmer, Lundstrom, and Moon, whether taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of claim 1 and claim 20, at least by reason of its dependency from independent claim 1, should be withdrawn.

Independent claims 21, 23, 33, 41, and 49, although of different scope, include features similar to those noted above with respect to claim 1. For at least the reasons given above, the rejection under 35 U.S.C. § 103(a) of claims 21, 23, 33, 41, and 49 should be withdrawn.

Regarding the motivation to combine, Applicants submit that one of ordinary skill in the art would not be motivated to make the Gemmer-Lundstrom-Moon combination proposed by the Examiner. Applicants submit that Gemmer has nothing to do charging indicators, much less placing a session on hold in response to an invitation message. Indeed, Gemmer relates allowing a user to invoke a hold command to place a call on hold, as noted above. Assuming for the sake of argument that one could selectively pluck aspects of Gemmer as alleged by the Examiner (although Applicants highly doubt that any such modification is even possible) and combine it with Lundstrom and Moon, Applicants submit that the modification would not work for its intended purpose because, as noted above, Gemmer's user driven invocation of the hold teaches away from claim 1. Moreover, Moon actually releases connections, as noted above. M.P.E.P. 2143.01 states "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ

1125 (Fed. Cir. 1984).“ Therefore, one of ordinary skill in the art would not be motivated to make the Gemmer-Lundstrom -Moon combination proposed by the Examiner. Therefore, the rejection of claims 1, 20, 21, 23, 33, 41, and 49 under 35 U.S.C. §103(a) as unpatentable over Gemmer in view Lundstrom and Moon should be withdrawn for this additional reason.

The Examiner rejected claims 2, 4-6, 8-19, 34-40, and 42-48 under 35 U.S.C. § 103(a) as unpatentable over Gemmer, Lundstrom, Moon, and APA. Applicants respectfully traverse this rejection.

Claims 2, 4-6, and 8-19 depend from claim 1 and include all the features recited therein. For at least the reasons noted above with respect to claim 1, neither Gemmer, Lundstrom, nor Moon discloses, at least the following features: “putting, in response to an invitation message, on hold a communication session between a user equipment associated with a first access network and a node of a communication system via a second network and at least one entity of said communication system between said user equipment and said node, the communication session established without preconditions to reserve resources for the communication session when the preconditions are not supported on the communication session between the user equipment and the node, the communication session established based on a session initiation protocol (SIP) and session data protocol (SDP),” and “resuming, in response to sending another invitation message and when the resources have been reserved, said communication session with the another message indicating an active session from said user equipment by which said charging identifier for the first access network is forwarded from said first node of the second network to a second node of the second

network, wherein the first access network is different from the second network." Moreover, APA does not cure the noted deficiencies of Gemmer, Lundstrom, and Moon. Nor does the Examiner allege that APA cures the above-noted deficiencies of Gemmer, Lundstrom, and Moon. Claims 34-40 and 42-48, although of different scope, each include features similar to those noted above with respect to claims 2, 4-6, and 8-19. Therefore, claims 2, 4-6, 8-19, 34-40, and 42-48, are allowable over Gemmer, Lundstrom, Moon, and APA, whether those references are taken alone or in combination, and the rejection of those claims under 35 U.S.C. §103(a) should be withdrawn.

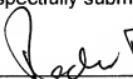
CONCLUSION

On the basis of the foregoing amendments, the pending claims are in condition for allowance. It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Applicant is concurrently filing herewith a Petition for a one-month extension of time with the requisite fee. Authorization for a credit-card payment of the filing fees mentioned above is submitted herewith. No additional fees are believed to be due, however the Commissioner is authorized to charge any additional fees or credit overpayments to Deposit Account No. 50-0311, reference No. 37343-502001US. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

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Respectfully submitted,



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